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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,473	02/06/2001	Ervin F. Johnston		8971
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ERVIN F. JOHNSTON 3829 SNEAD DRIVE SIERRA VISTA, AZ 85650			EXAMINER KARMIS, STEFANOS	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 06/22/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/777,473

**Applicant(s)**

JOHNSTON, ERVIN F.

**Examiner**

STEFANOS KARMIS

**Art Unit**

3693

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 84-91 and 100-107 and 116-131 is/are pending in the application.
- 4a) Of the above claim(s) 116-131 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 84-91 and 100-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is in reply to the remarks filed 17 April 2009.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 April 2009 has been entered.

***Status of Claims***

3. Claims 84-91, and 100 are currently amended. Claims 116-131 are newly added. Claims 84-91, 100-107, and 116-131 are currently pending.

***Election/Restrictions***

4. Newly submitted claim 116-131 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 84-91, 100-107, classified in 705/40, are drawn to a method for an internet hosted bill paying and transaction sorting system. The debtor computer screen can simultaneously display different transactions and the debtor can insert category tags so that the transactions can be sorted. Claims 116-131 are not directed at a transaction sorting system, but rather sorting a plurality of files. Further, the sorting of files is done based on primary notation.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 116-131 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Arguments***

5. Applicant's arguments regarding the rejection of claims 84-91, and 100-107 under Chiasson in view of Kitchen, filed 17 April 2009, have been fully considered and are moot in view of the new grounds of rejection discussed below.
6. Applicant's arguments regarding claims 116-131 have been considered but are moot in view of the election/restriction requirement above. These claims are withdrawn from consideration in this office action.
7. Regarding claims 84-91, and 100-107 (Examiner notes this applies to all independent claims, and also their dependents), Applicant request clarification of Examiner's interpretation of the preamble. Examiner notes that the claims are not objected to because of the preamble. Rather, the Examiner is merely pointing out the patentable weight given to the preamble. For example, the preamble of claim 84 recites various steps that are not discussed in the body of the claim. The preamble of claim 84 recites "a creditor that has a creditor's computer and at least one monetary funding activity" and "paying a bill." The body of claim 84, however is drawn to sorting on the debtor's computer and makes no mention of a creditor, a creditor computer, a monetary funding account or paying a bill. Therefore, those recitations in the preamble are not

accorded patentable weight because it merely recited the purpose of a process or the intended use of a structure and the body does not depend on the preamble for completeness.

8. Applicant's arguments regarding the rejection under 35 U.S.C. 112, second paragraph are persuasive given Applicant's interpretation. The Examiner understands this to be that unsorted transaction can in fact be sorted from the creditor, they are merely transactions which the debtor has never sorted before based on debtor criteria or own choosing.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 84-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiasson U.S. Publication 2002/0002513 in view of Kitchen et al. (hereinafter Kitchen) U.S. Patent 6,289,322 in further view of Simpson et al. (hereinafter Simpson) U.S. 6,934,691.

Regarding claims 84, 92, 100 and 108, Chiasson teaches a method for an internet hosted bill paying system: Chiasson teaches upon one or more commands by the debtor, enabling the debtor to create bill categories and organizing bills based on bill categories (page 11, paragraphs 106-109). Chiasson further teaches displaying the bills and viewing the bills in the bill category on the debtor's computer screen (page 12, paragraph 0111 and paragraph 0114). Chiasson fails to show a debtor's computer and a debtor's computer screen that is responsive to the debtor's

computer, at least one creditor that has a creditor's computer as well as the graphical representation.

Kitchen teaches enabling a simultaneous display of said plurality of unsorted transactions on the debtor's computer screen with each unsorted transaction of at least some of the unsorted transactions having fields filled with transaction data which are pertinent to the unsorted transaction (Fig. 8 and Fig 9C; column 12, lines 55-65 and column 14, lines 33-45). Kitchen teaches electronic bill processing between a debtor's computer and a creditor computer (Figures 1 and 2). Kitchen also teaches the a graphical representation with buttons for adding categories and viewing or sorting by the categories (Figure 8, 14 and 9A and column 13, line 1 thru 25 and column 13, line 48 thru column 14, line 15). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the category teachings of Chiasson to include the graphical representation and computer network teachings of Kitchen because it allows for the visual representation and organization of bills in a computer network.

Therefore, Chiasson in view of Kitchen teaches assigning bills to designated categories, such as utilities, school, tennis, credit cards, etc. Chiasson in view of Kitchen fails to teach a simultaneous display of the unsorted bills, wherein each of the unsorted transactions have open fields for insertion of the category. Simpson teaches a system and method for managing bills in which an online bill summary report shows a list of bills and related transaction information (column 8, lines 33-57 and Figure 8). Simpson further teaches an open field (262) remarks box that contains miscellaneous information regarding the merchant and/or the current past bills. Simpson fails to teach that the bills are sorted based on this criteria.

However, it would have been obvious to combine the teachings of Chiasson in view of Kitchen for sorting bills based on categories, in which the categories contain information regarding the merchant, to include the remarks teachings of Simpson, which include remarks about the merchant because it allows the viewers to get a more detailed bill summary and to assign the appropriate categories to bills and view the bills based on a desired category. Further, the Kitchen bill summary in Fig 9C is very similar to the Simpson summary in Figure 8 and it would be obvious to add the last columns of remarks to Kitchen and perform sorting based on category directly from the bill summary page.

Claims 85, 93, 101, 109, Chiasson teaches further comprising the step of: enabling a display of said plurality of category items as category item buttons on the debtor's computer screen so that the debtor can activate selected category item buttons for displaying said selected category items in said selected open fields on the debtor's computer screen (page 11, paragraph 109). Kitchen also teaches enabling a display of said plurality of category items as category item buttons on the debtor's computer screen so that the debtor can activate selected category item buttons for displaying said selected category items in said selected open fields on the debtor's computer screen (Figure 8 and 9A and column 13, line 1 thru 25 and column 13, line 48 thru column 14, line 15).

Claims 86, 94, 102 and 110, Chiasson fails to teach the graphical representation of rows on the computer screen. Kitchen teaches the steps off enabling a display of rows of line items on

the debtor's computer screen with each line item representing a transaction and having transaction data columns and a category item column wherein the transaction column has fields filled with said transaction data and said the category item column has an open field; upon the debtor activating a selected line item and then activating a selected category item button, enabling a display of the open field for the selected line item filled with the category item associated with the selected category item button (Figure 9C).

Regarding claims 87-89, 95-97, 103-105 and 111-113, Chiasson in view of Kitchen teaches the use of categories for labeling bills and viewing bills.

Claims 90, 98, 106 and 114, Chiasson teaches that bills are for products or services purchases. Chiasson fails to show the graphical representation. Kitchen teaches displaying at least some of the sorted transactions on the debtor's computer screen which includes at least product or services purchased, amount paid for the product or services and date paid transaction data (Figure 9B and Figure 11 and Figure 13).

Claims 91, 99, 107 and 115, Chiasson in view of Kitchen teach approving the bill paying. Chiasson in view of Kitchen fail to teach enabling the display of an account balance in a monetary funding account with the monetary funding activity on the debtor's computer screen. Official Notice is taken that viewing account balances before paying bills is old and well known



in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Chiasson in view of Kitchen to allow for viewing the account balance before paying the bills because it allows a check to see if there is sufficient funds to cover the bill amount.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted  
/Stefanos Karmis/  
Primary Examiner, Art Unit 3693  
22 June 2009